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No. 92-863

IN THE

Supreme Court of the United States

OCTOBER TERM, 1992

FRITO-LAY, INC. and TRACY-LOCKE, INC.,

Petitioners,

—v.—

TOM WAITS,

Respondent.

REPLY BRIEF IN FURTHER SUPPORT OF PETITION FOR A WRIT OF CERTIORARI

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ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

PETITIONER'S REPLY BRIEF IN FURTHER SUPPORT OF PETITION FOR CERTIORARI

Frito-Lay, Inc. and Tracy-Locke, Inc. respectfully submit this reply memorandum of law in further support of their petition that a writ of

certiorari issue to review the opinion of the United States Court of Appeals for the Ninth Circuit entered in this action on August 5, 1992, and amended October 6, 1992 and October 22, 1992.

REASONS FOR GRANTING THE WRIT

POINT I

THE TORT OF MISAPPROPRIATION OF VOICE IS PREEMPTED BY SECTION 301 OF THE COPYRIGHT ACT OF 1976

Section 301 of the Copyright Act provides that a state law is preempted if two conditions are met: (1) the right created by state law must be "equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106," and (2) the right created by state law must be in a work of authorship that is "fixed in a tangible medium of expression and come[s] within the subject matter of copyright as specified by sections 102

and 103" of the Copyright Act. 17 U.S.C. § 301(a).

First, respondent argues that the so-called "Midler tort" is not equivalent to any of the copyright holder's exclusive rights because evidence of actual consumer confusion is a requirement of the Midler tort. Respondent's Brief in Opposition, p. 8. In fact, however, although the district court did charge the jury on actual confusion, the Ninth Circuit noted that evidence of actual confusion was not required by its opinion in Midler v. Ford Motor Company, 849 F.2d 460, 463 (9th Cir. 1988), cert. denied, 112 S. Ct. 1513 (1992) ("Midler"), and expressly declined to rule on the propriety of the district court's instruction in this case. Tom Waits v. Frito-Lay, Inc. and Tracy-Locke, Inc., (9th Cir. 1992) (August 5, 1992,

amended October 6, 1992 and October 22, 1992) (Appendix to the Petition at A16, n. 3). Accordingly, the Midler tort, as set forth by the Ninth Circuit, does not require a showing of actual confusion. To the contrary, the tort is committed by the mere act of copying, and is therefore equivalent to one of the exclusive rights belonging to the copyright owner.

Second, respondent relies upon this Court's opinion in Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1976), for the broad proposition that a state-protected right of publicity is not preempted by the Copyright Act. However, in Zacchini, the Court was not faced with a claim of preemption; indeed § 301 of the Copyright Act was not yet enacted. Instead, Zacchini held that a news broadcast of an unauthorized videotape of plaintiff's cannonball

"performance" was not privileged under the First and Fourteenth Amendments.[1]

Thus, because the "Midler tort" is equivalent to the exclusive rights of the copyright owner with respect to the subject matter of copyright, it is preempted under Section 301.

POINT II

THE NINTH CIRCUIT'S OPINION IS IN CONFLICT WITH THE OPINIONS OF OTHER CIRCUITS ON PREEMPTION

The Ninth Circuit's holding that Waits' voice is not the subject

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[1] Moreover, as set forth in Point II, infra, even if the Court was faced with a preemption issue in Zacchini, which it was not, Zacchini is distinguishable from this case because Zacchini did not consent to the taping of his performance. Because the taping was without consent, the performance was not "fixed" and therefore was not the "subject matter of copyright." In this case, plaintiff consented to the fixation of his voice in a sound recording, "Step Right Up." The voice on that sound recording is clearly the subject matter of copyright.

matter of copyright because it is not fixed conflicts with the Seventh Circuit's holding in Baltimore Orioles v. Major League Baseball Players, 805 F.2d 663 (7th Cir. 1986), cert. denied, 480 U.S. 941 (1987), and with the District of Columbia District Court's holding in Brown v. Twentieth Century Fox Film Corp., 799 F. Supp. 166 (D.D.C. 1992).

Respondent argues that Baltimore Orioles does not apply because plaintiff "did not consent to the use of his voice or an imitation of his voice, in a snack food commercial." Respondent's Brief in Opposition, p. 14. This argument completely misses the point. The point is that respondent consented to the fixation of his voice in a sound recording, which sound recording was copied by petitioners.

Respondent relies upon the

Seventh Circuit's analysis of the fact pattern in Zacchini. As respondent notes, the Seventh Circuit in Baltimore Orioles distinguished Zacchini, and concluded that Zacchini's claim would not have been preempted because the work was not recorded "by" Zacchini -- that is, Zacchini did not consent to the taping of his performance. Therefore, the performance was not fixed and was not the subject matter of copyright.

Like the plaintiffs in Baltimore Orioles, and unlike the plaintiff in Zacchini, respondent here consented to the fixation of his performance: he willingly made a sound recording of "Step Right Up." Having done so, the sounds contained therein are "fixed," and are the subject matter of copyright.

Respondent also argues that

Brown v. Twentieth Century Fox Film Corp., is not in conflict with the Ninth Circuit's opinion because in Brown, defendants had lawfully acquired the rights to plaintiff's fixed performance. However, that is precisely the point. In this case, under § 114(b) of the Copyright Act, petitioners lawfully had the right to duplicate the sounds contained in respondent's copyrighted sound recording, including his voice. As the court in Brown correctly recognized, because petitioners lawfully had the right to duplicate the sounds in respondent's sound recording, "violation of the right of publicity cannot be based on" such duplication. Id., 799 F. Supp. at 172.

Accordingly, because there is no valid distinction between the Ninth Circuit's conclusion that respondent's

voice is not "fixed," and the Seventh Circuit's and the District of Columbia District Court's conclusion that plaintiffs' performances were "fixed," this Court should grant certiorari to resolve the conflict between the Circuit courts.

CONCLUSION

The common law tort of misappropriation of voice created by the Ninth Circuit imposes liability for the mere imitation of a sound recording, conduct explicitly permitted by Section 114(b) of the Copyright Act, and is therefore clearly preempted by Section 301 of the Copyright Act.

The Ninth Circuit's creation of this tort and its holding on preemption is in conflict with the holding of the Seventh Circuit in Baltimore Orioles, Inc. v. Major League Baseball Players

Assoc., 805 F.2d 663 (7th Cir. 1986), cert. denied, 480 U.S. 941 (1987), and with the District of Columbia District Court's holding in Brown v. Twentieth Century Fox Film Corp., 799 F. Supp. 166 (D.D.C. 1992), thereby creating uncertainty and inconsistency in an area where a uniform national rule is needed.

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